55/248

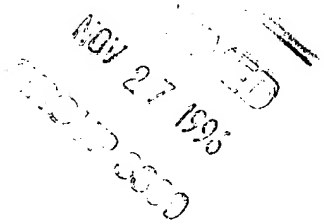
#12

"PATENT"

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)	
	)	
S.D. Augustine et al	)	Group No.: 3304
	)	
Serial No.: 08/419,719	)	
	)	Examiner: M. Graham
Filed: April 10, 1995	)	
	)	
For: THERMAL BLANKET	)	

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231



Dear Sir:

TERMINAL DISCLAIMER

Your Petitioner, AUGUSTINE MEDICAL, INC., represents that:

by virtue of an Assignment recorded in the United States Patent Office on 6/25/92, at Reel 6147, Frame 0720, it is the owner of the entire right and interest in United States Patent 5,184,612, which issued February 9, 1993;

by virtue of an Assignment recorded in the United States Patent Office on 2/23/90 at Reel 5244, Frame 0712 it is the owner of the entire right and interest in United States Patent Application Serial No. 07/227,189 (abandoned);

300 SD 11/19/96 08419719
1 248 55.00 CK

F:\WP60\USERS\CLARE\AUGUSTIN\1382-119.TDC

by virtue of an Assignment recorded in the United States Patent Office on 8/31/90 at Reel 5427, Frame 0875, it is the owner of the entire right and interest in United States Patent Application No. 07/550,757 (a continuation-in-part of United States Serial No. 07/227,189, and now abandoned); and

by virtue of an Assignment recorded in the United States Patent Office on 4/13/92 at Reel 6082, Frame 0560, it is the owner of the entire right and interest in United States Patent Application Serial No. 07/638,748 (a continuation-in-part of United States Serial No. 07/550,757, and now United States Patent No. 5,405,371), and thereby the owner of the entire right and interest in this patent application, United States Patent Application Serial No. 08/419,719 (a continuation of United States Serial No. 07/638,748).

Your petitioner, AUGUSTINE MEDICAL, INC., hereby disclaims the terminal part of any patent granted on United States Patent Application Serial No. 08/419,719 which would extend beyond the expiration date of United States Patent 5,184,612 and hereby agrees that any patent so granted on United States Patent Application Serial No. 08/419,719 shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent 5,184,612, this agreement to run with any patent granted on United States Patent Application Serial No. 08/419,719 and to be binding upon the grantee, its successors or assigns.

I have reviewed the evidentiary documents concerning ownership of United States Patent 5,184,612 and United Application Serial No. 08/419,719 and, to the best of my knowledge and belief, they establish the entire right, title, and interest to United States Patent 5,184,612 and to United States Patent Application Serial No. 08/419,719 in AUGUSTINE MEDICAL, INC.

I, JOHN E. THOMAS, am President of AUGUSTINE MEDICAL, INC., and I am authorized to sign this Terminal Disclaimer on behalf of AUGUSTINE MEDICAL, INC.

Dated: 5/22/96

JOHN E. THOMAS, President
AUGUSTINE MEDICAL, INC.

ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 202

RECEIVED
MAY 03 1990
Baker, Maxham, Jester & Meador

TO: TERRANCE A. MEADOR
BAKER, MAXHAM, JESTER & MEADOR
SUITE 1202
110 WEST "C" STREET
SAN DIEGO, CA 92101

UNITED STATES PATENT AND TRADEMARK OFFICE
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ASSIGNOR: 001 AUGUSTINE, SCOTT D. DOC DATE: 02/07/90
ASSIGNOR: 002 AUGUSTINE, DOUGLAS J. DOC DATE: 02/07/90

RECORDATION DATE: 02/23/90 NUMBER OF PAGES 001 REEL/FRAME 5244/0712

DIGEST: ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE: 501 AUGUSTINE MEDICAL, INC., 10393 WEST 70TH STREET, SUITE 10 0, EDEN PRAIRIE, MN A CORP. OF MN

SERIAL NUMBER 7-227189 FILING DATE 08/02/88
PATENT NUMBER ISSUE DATE 00/00/00

TITLE OF INVENTION: THERMAL BLANKET

INVENTOR: 001 AUGUSTINE, SCOTT D.
INVENTOR: 002 AUGUSTINE, DOUGLAS J.

ASSIGNMENT

WHEREAS, SCOTT D. AUGUSTINE, 9017 Cavell Circle, Bloomington, Minnesota, 55438, and DOUGLAS J. AUGUSTINE, 18546 Avon Court, Eden Prairie, Minnesota, 55346, hereinafter referred to as Assignors have acquired rights to a certain invention and a United States patent application covering the same; and

WHEREAS, in accordance with the terms of an agreement dated 7/15/87, the Assignors have agreed with AUGUSTINE MEDICAL, INC., a corporation of the State of Minnesota, having a principal place of business at 10393 West 70th Street, Suite 100, Eden Prairie, Minnesota, 55344, hereinafter referred to as the Assignee, the Assignors have agreed to assign these rights to the Assignee; and

NOW, THEREFORE, be it known that for good and valuable consideration, the Assignors do hereby formally grant, bargain, sell, transfer, convey and assign to the Assignee, its successors, legal representatives or assigns, the entire right, title, and interest in and to United States Patent Application Serial No. 07/227,189, filed August 2, 1988 and entitled "THERMAL BLANKET", and all continuations and divisions thereof, said U.S. Patent Application to be held and enjoyed by the Assignee for its own use and enjoyment and for the use and enjoyment of its successors, assigns or other legal representatives as fully and entirely as the same would have been held and enjoyed by the Assignors had this Assignment not been made.

The Assignors covenant that they have the right to grant this Assignment.

Executed at Eden Prairie, Minnesota, this 7th day of February, 1990.

Scott D Augustine
SCOTT D. AUGUSTINE

Douglas J Augustine
DOUGLAS J. AUGUSTINE

Witness: Terrance J. Meade

RECORDED
PATENT & TRADEMARK OFFICE
FEB 23 90

REEL 5241 FRAME 712

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

TO: TERRANCE A. MEADOR
BAKER, MAXHAM, JESTER & MEADOR
110 WEST "C" ST,. STE. 1202
SAN DIEGO, CA 92101

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ASSIGNOR: 001 AUGUSTINE, SCOTT D. DOC DATE: 08/21/90
ASSIGNOR: 002 ARNOLD, RANDALL C. DOC DATE: 08/22/90

RECORDATION DATE: 08/31/90 NUMBER OF PAGES 003 REEL/FRAME 5427/0875

DIGEST: ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE: 501 AUGUSTINE MEDICAL, INC., 10393 WEST 70TH ST., STE. 100, E DEN PRAIRIE, MN 55344

SERIAL NUMBER 7-550757 FILING DATE 07/10/90
PATENT NUMBER ISSUE DATE 00/00/00

FRELING E. BAKER
LAWRENCE A. MAXHAM
MICHAEL H. JESTER
TERRANCE A. MEADOR

WALTER W. DUFT

BAKER, MAXHAM, JESTER & MEADOR
A PROFESSIONAL CORPORATION
ATTORNEYS AT LAW
SUITE 1202
110 WEST "C" STREET
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NORTH COUNTY OFFICE
2111 PALOMAR AIRPORT ROAD
SUITE 330
CARLSBAD, CA 92009
(619) 438-3007

August 28, 1990

Hon. Commissioner of Patents and Trademarks
Washington, D. C. 20231

Dear Sir:

Enclosed please find an Assignment from SCOTT D. AUGUSTINE, and RANDALL C. ARNOLD to AUGUSTINE MEDICAL, INC., for U.S. Patent Application Serial No. 07/550,757, filed July 10, 1990, for "THERMAL BLANKET".

Kindly record the enclosed Document and return it to the undersigned.

Our check in the amount of $8.00 is enclosed for the recordal fee. If any additional fees arise in connection with this recording which are not covered by the money enclosed, please charge such fees, or credit any overpayment, to Deposit Account No. 02-0460. A duplicate copy of this letter is enclosed.

Very truly yours,

BAKER, MAXHAM, JESTER & MEADOR

Terrance A. Mead

TERRANCE A. MEADOR
Registration No. #30,298

TAM/cmr
Enclosures

91124708

060 MC 09/11/90 07550757 1 518 8.00 CK

ASSIGNMENT

TO WHOM IT MAY CONCERN

For valuable consideration, be it known that we, SCOTT D. AUGUSTINE, 9017 Cavell Circle, Bloomington, Minnesota, 55438, and RANDALL C. ARNOLD, 1701 Payne Avenue, Maplewood, Minnesota, 55117, have sold, assigned and transferred and by these presents do sell, assign, transfer and set over unto AUGUSTINE MEDICAL, INC., 10393 West 70th Street, Suite 100, Eden Prairie, Minnesota, 55344, its successors, legal representatives, or assigns, our whole right, title and interest, in and to a certain invention relating to "THERMAL BLANKET" and United States Patent Application therefor, Serial No. 07/550,757, filed in the United States Patent and Trademark Office on July 10, 1990, and all original and reissue patents granted thereof, and all divisions and continuations thereof, including the subject matter of any and all claims in every such patent, and all foreign rights to said invention, and covenant that we have full right to do so, and agree that we will communicate to said AUGUSTINE MEDICAL, IN., or its representatives all facts known to us respecting said invention, whenever requested, and testify in any legal

proceedings, sign all lawful papers, make all rightful oaths and generally do everything possible to aid said AUGUSTINE MEDICAL, INC., its successors, assigns, and nominees, to obtain and enforce proper patent protection for said invention in the United States of America and throughout the World.

The Commissioner of Patents and Trademarks is requested to issue the Letters Patent which may be granted for said invention or any part thereof unto said AUGUSTINE MEDICAL, INC., in keeping with this Assignment.

Dated: 8/21/90

Scott D Augustine
SCOTT D. AUGUSTINE

Dated: 8/22/90

Randall C Arnold
RANDALL C. ARNOLD

Dated: 8-22-90

Kathleen White
WITNESS

RECORDED
PATENT AND TRADEMARK
OFFICE

AUG 31 1990

REEL 5427 FRAME 877

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

DATE: 05/11/92
TO:
TERRANCE A. MEADOR
BAKER, MAXHAM, JESTER & MEADOR
750 B STREET, SE. 2770
SAN DIEGO, CA 92101

UNITED STATES PATENT AND TRADEMARK OFFICE
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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT ASSIGNMENT PROCESSING SYSTEM. IF YOU SHOULD FIND ANY ERRORS, ON THIS NOTICE, PLEASE SEND A REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT BRANCH, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231

ASSIGNOR: DOC DATE: 01/07/91
AUGUSTINE, SCOTT D.

ASSIGNOR: DOC DATE: 01/07/91
ARNOLD, RANDALL C.

RECORDATION DATE: 04/13/92 NUMBER OF PAGES 003 REEL/FRAME 6082/0560

DIGEST :ASSIGNMENT OF ASSIGNORS INTEREST

ASSIGNEE:
AUGUSTINE MEDICAL, INC.
10393 WEST 70TH STREET, STE. 100, EDEN PRAIRIE, MN 55344

SERIAL NUMBER 7-638748 FILING DATE 01/08/91
PATENT NUMBER ISSUE DATE 00/00/00

FRELING E. BAKER
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MICHAEL H. JESTER
TERRANCE A. MEADOR

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HC11 551 F

April 10, 1992

Hon. Commissioner of Patents and Trademarks
Washington, D. C. 20231

Re: Assignment Recordal Request for
U.S. Patent Application for
"THERMAL BLANKET"
Our Ref.: 1342 35

Dear Sir:

Enclosed please find an Assignment from SCOTT D. AUGUSTINE and RANDALL C. ARNOLD, to AUGUSTINE MEDICAL, INC., for U.S. Patent Application Serial No. 07/638,748, filed January 8, 1991, for "THERMAL BLANKET".

Kindly record the enclosed Document and return it to the undersigned.

Our check in the amount of $40.00 is enclosed for the recordal fee. If any additional fees arise in connection with this recording which are not covered by the money enclosed, please charge such fees, or credit any overpayment, to Deposit Account No. 02-0460. A duplicate copy of this letter is enclosed.

Very truly yours,

BAKER, MAXHAM, JESTER & MEADOR

Terrance A. Meador

TERRANCE A. MEADOR
~~Registration No.~~ #30,298

91620959

TAM/cmr
Enclosures

050 LP 04/17/92 07638748 1 581 40.00 CK

ASSIGNMENT

TO WHOM IT MAY CONCERN

For valuable consideration, be it known that we, SCOTT D. AUGUSTINE, 9017 Cavell Circle, Bloomington, Minnesota, 55438, and RANDALL C. ARNOLD, 1701 Payne Avenue, Maplewood, Minnesota, 55117, have sold, assigned and transferred and by these presents do sell, assign, transfer and set over unto AUGUSTINE MEDICAL, INC., 10393 West 70th Street, Suite 100, Eden Prairie, Minnesota, 55344, its successors, legal representatives, or assigns, our whole right, title and interest, in and to a certain invention relating to "THERMAL BLANKET" and United States Patent Application therefor, executed on even date herewith, and all original and reissue patents granted thereof, and all divisions and continuations thereof, including the subject matter of any and all claims in every such patent, and all foreign rights to said invention, and covenant that we have full right to do so, and agree that we will communicate to said AUGUSTINE MEDICAL, INC., or its representatives all facts known to us respecting said invention, whenever requested, and testify in any legal

proceedings, sign all lawful papers, make all rightful oaths and generally do everything possible to aid said AUGUSTINE MEDICAL, INC., its successors, assigns, and nominees, to obtain and enforce proper patent protection for said invention in the United States of America and throughout the World.

The Commissioner of Patents and Trademarks is requested to issue the Letters Patent which may be granted for said invention or any part thereof unto said AUGUSTINE MEDICAL, INC., in keeping with this Assignment.

Dated: 1/7/91

SCOTT D. AUGUSTINE

Dated: 1/7/91

RANDALL C. ARNOLD

Dated: 7 Jan 91

WITNESS

RECORDED
PATENT AND TRADEMARK
OFFICE
APR 13 1992

REEL 6082 FRAME 562

COMBINED PETITION FOR REHEARING AND SUGGESTION FOR REHEARING IN BANC OF PLAINTIFF-CROSS-APPELLANT AUGUSTINE MEDICAL, INC.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

98-1001,
-1002, -1054, -1244, -1266

AUGUSTINE MEDICAL, INC.,

Plaintiff-Cross-Appellant,

v.

GAYMAR INDUSTRIES, INC.
and MEDISEARCH P R, INC.,

Defendants-Appellants,

and

MALLINCKRODT GROUP, INC.
and MALLINCKRODT MEDICAL, INC.,

Defendants-Appellants.

Appeal from the United States District Court for the District of Minnesota in 94-CV-875, 94-CV-888, 96-CV-347 and 96-CV-1145, Judge James M. Rosenbaum

---

Jacob M. Holdreith
Craig J. Lervick
Elizabeth A. Wefel
Cyrus A. Morton
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ATTORNEYS FOR PLAINTIFF-CROSS-APPELLANT AUGUSTINE MEDICAL, INC.

June 21, 1999

CERTIFICATE OF INTEREST

Pursuant to Rule 47.4 of the Rules of this Court, Plaintiff-Cross-Appellant Augustine Medical, Inc. submits this Certificate of Interest as follows:

1. The full name of the party represented by counsel listed below is: Augustine Medical, Inc.

2. Augustine Medical, Inc. is the real party in interest in this case.

3. Augustine Medical, Inc. has no parent companies, subsidiaries or affiliates that have issued shares to the public.

4. The names of all law firms and the partners or associates that have appeared for the parties now represented by the undersigned in the trial or who are expected to appear in this Court are:

Jacob M. Holdreith
Craig J. Lervick
Elizabeth A. Wefel
Cyrus A. Morton
OPPENHEIMER WOLFF & DONNELLY LLP
3400 Plaza VII Building
45 South Fourth Street
Minneapolis, Minnesota 55402
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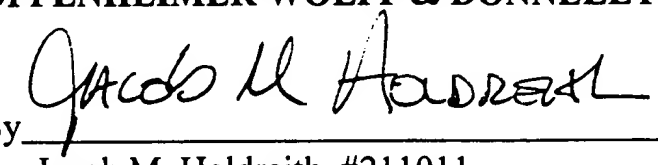
J. Randall Benham
Telephone: (612) 947-1200

5. The names of attorneys that have appeared for the parties now represented by the undersigned who are no longer associated and/or affiliated with the undersigned firm are:

Linda J. Sorrano
Robert M. Rauker
Timothy M. Kenny

Date: June 21, 1999

OPPENHEIMER WOLFF & DONNELLY LLP

By 

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ATTORNEYS FOR PLAINTIFF-CROSS-APPELLANT AUGUSTINE MEDICAL, INC.

TABLE OF CONTENTS

TABLE OF AUTHORITIES

CASES

STATEMENT OF COUNSEL

Based on my reasoned and studied professional judgment, I believe the panel decision is contrary to the following precedent of this Court: *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 48 U.S.P.Q.2d 1001 (Fed. Cir. 1998).

Based on my reasoned and studied professional judgment, I believe this appeal requires answer to one or more precedent-setting questions of exceptional importance: Whether the right to trial by jury granted in the Seventh Amendment to the Constitution of the United States is offended by the failure to give deference to the jury's determination of the scope of estoppel a reasonable competitor could rely on from a reading of the claims, specification and file history?

/s/ Jacob M Houbers

ATTORNEY OF RECORD FOR
PLAINTIFF-CROSS-APPELLANT
AUGUSTINE MEDICAL, INC.

POINTS OF LAW OR FACT

I. **THE COURT DID NOT CONSIDER, AND ITS DECISION NOW CONFLICTS WITH, THE DIRECTLY APPLICABLE PRECEDENT OF *COMARK COMMUNICATIONS INC. V. HARRIS CORP.* THAT THE BURDEN IS ON THE APPELLANT TO SHOW EITHER THAT THE JURY COULD NOT REASONABLY FIND A PARTICULAR LIMITATION LITERALLY OR THAT THERE WAS NOT SUFFICIENT EVIDENCE ON EQUIVALENTS AS TO ANY ELEMENT.**

II. **THIS PROCEEDING INVOLVES A QUESTION OF EXCEPTIONAL IMPORTANCE, NAMELY WHETHER THE JURY SHOULD BE AFFORDED ANY DEFERENCE AS TO THE FACTUAL INQUIRY OF WHAT A COMPETITOR WOULD REASONABLY CONCLUDE IN DETERMINING THE SCOPE OF ESTOPPEL.**

FACTS RELEVANT TO BOTH PETITION AND SUGGESTION

I. TRIAL COURT PROCEEDINGS.

Appellee-Cross Appellant Augustine Medical, Inc. ("Augustine") brought an action for infringement of four patents directed to convective warming blankets against Appellants Gaymar Industries, Inc. ("Gaymar") and Mallinckrodt Group, Inc. ("Mallinckrodt"). Addendum ("Add.") at 3. The patents in suit are U.S. Patent Nos. 5,300,102 ("the '102 patent"), 5,324,320 ("the '320 patent"), 5,405,371 ("the '371 patent") and 4,572,188 ("the '188 patent"). Add. at 3. The patented convective warming blankets are used before, during and after surgery to control a pateint's body temperature by bathing the patient in circulating warm air. Add. at 4. At trial, all elements of Augustine's claims were disputed and

submitted to the jury including "self-erecting," "discontinuous seams" attaching the upper and lower sheets of the blankets, and "chambers."

The trial court instructed the jury that "self-erecting" means the inflated blanket forms a "curved or arched structure which stands off the patient." Add. at 9; JA04184 ll. 4-6. The trial court had denied Appellants' motions for summary judgment with respect to the "self-erecting" limitation, ruling it is a jury question of whether the accused blankets literally self-erect. Add. at 9. Augustine put on a case of literal and equivalent infringement. Appellants conceded at trial that a "self-erecting" blanket can contact the patient at some points, but argued that the accused blankets exhibited too much contact to meet the self-erecting limitation literally. Thus, a substantial fact question for the jury was whether, in operation, the accused blankets "stand off" the patient.

At Appellants' request, the jury was instructed to consider the scope of any prosecution history estoppel. JA04186-04187 ll. 20-5. The jury returned a general verdict of infringement of numerous claims of the '102, '320 and '371 patents under the doctrine of equivalents. Add. at 11. The verdict form did not specify which elements were found literally and which were found equivalently. JA00018-00028A.

II. APPEAL.

Gaymar and Mallinckrodt appealed, arguing prosecution history estoppel as to the claim element "self-erecting" and challenging the sufficiency of the evidence of equivalence as to all elements. Mallinckrodt Brief at pp. 32-39, 42-49; Gaymar Brief at 25-45. Appellants did not appeal the trial court's definition of "self-erecting," namely, "forms a curved or arched structure which stands off the patient." Add. at 9.

This Court quoted with approval the trial court's claim definition "forms a curved or arched structure that stands off the patient." Add. at 11. This Court observed that the magistrate judge noted that "the Mallinckrodt blanket move[d] slightly away from the person underneath it and assume[d] a shape over the person" when in operation, and the Gaymar "blanket lift[ed] slightly away from the table as it [was] inflated." Add. at 8. Finally, this Court noted that the trial court found an issue of fact which was submitted to the jury as to whether the accused blankets self-erect literally. Add. at 9.

Although many elements were disputed and there was no special verdict form specifying how each element was met, this Court implicitly concluded that the jury did not find the "self-erecting" limitation literally and ruled that prosecution history estoppel precluded a finding of "self-erecting" by equivalents.

Add. at 4 & 11. It appears that this Court further construed "self-erecting" to include the additional limitation "self-supporting," which appears in dependent claim five of the '188 patent, and ruled that the accused blankets are not literally "self-supporting" as a matter of law. Add. at 11.

The Detailed Description Of The Preferred Embodiments in the '188 patent describes a "self-supporting" blanket as one where "the edges curl down around the patient" such that the blanket "contacts the patient only at the tubes which are immediately adjacent to keystone tube." JA04302 col. 4 ll. 7-16. The specifications of the other patents-in-suit note that "tubes are preferred since they impart shape and strength to the erected bathing structure; other inflatable structures are contemplated, however." (Emphasis added.) JA04430 col. 4 ll. 63-66; JA04631 col. 4 ll. 33-36; JA05038 col. 5 ll. 31-34.

This Court did not explicitly address literal claim scope, nor did it address the open question of literal infringement. Furthermore, this Court chose to disregard its recent precedent in *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 1998) pertaining to jury verdicts under the doctrine of equivalents where no special interrogatory is used to show which elements are found equivalently and which are found literally.

Consequently, Augustine has filed this combined petition for rehearing and suggestion for rehearing in banc.

ARGUMENT -- PETITION FOR REHEARING

I. THIS COURT'S DECISION IN *COMARK COMMUNICATIONS INC. V. HARRIS CORP.* IS DIRECTLY ON POINT AND MUST BE CONSIDERED.

The jury rendered a verdict of infringement of the asserted claims, but did not specify which limitations were met by equivalents. Thus the record does not reveal whether the particular limitation of "self-erecting" was found literally or equivalently. Following the close of briefing in this case, this Court decided *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 1998). This Court articulated the following rule:

> Where there is no specific finding by the jury of equivalence as to a particular element, and the defendant has not successfully argued that a particular limitation could not be met literally, the defendant has assumed the burden of proving not only that there is insufficient evidence under *Lear Siegler* for a jury to find that the limitation could be met equivalently, it must also establish that there is no substantial evidence in the record that would permit the jury to find that any limitation has been met by equivalents.

Comark, 156 F.3d at 1189, 48 U.S.P.Q.2d at 1006 (emphasis in original). Thus, in this case, Gaymar and Mallinckrodt must show either that the jury could not have found that the accused blankets literally "self-erect" or that there was not

sufficient evidence on equivalence as to any limitation. If they cannot, this Court must uphold the jury verdict. *See id.* at 1188, 48 U.S.P.Q.2d at 1006.

A. Neither Gaymar Nor Mallinckrodt Satisfied Its Burden Under *Comark*.

Gaymar and Mallinckrodt did not argue on appeal that the jury could not have found that their blankets literally self-erect. Nor did they dispute the trial court's instruction that self-erecting means the blanket "forms a curved or arched structure which stands off the patient." Add. at 11. Instead, Appellants focused their argument on the sufficiency of the evidence to support a finding of infringement as to any of the five disputed elements under the doctrine of equivalents. This Court did not analyze and should not reasonably find that the self-erecting limitation could not literally have been met under the instruction given, nor did this Court rule that there was insufficient evidence to find any element by equivalents.

B. The Record Demonstrates That The Jury Could Have Found Literal Infringement Of The "Self-Erecting" Limitation.

This Court noted the following evidence in the record:

> With respect to the other patents, the magistrate judge detected a genuine issue of material fact relative to the "self-erecting" limitation. Specifically, the magistrate judge noted that "the Mallinckrodt blanket move[d] slightly away from the person underneath it and assume[d] a shape over the person" when in operation. When considering the Gaymar blanket, the magistrate judge explained that "the blanket lift[ed] slightly away from the table as it [was] inflated."

Add. at 8. Based on this evidence, both the magistrate and the trial court "identified the same issue of material fact regarding whether Gaymar's and Mallinckrodt's blankets literally or equivalently self-erect." *Id.* at 9 (emphasis added). The trial court submitted literal and equivalent infringement to the jury and this Court did not find any fault with the charge to the jury regarding the definition of self-erecting; in fact, this Court affirmed the trial court's claim definition: "the district court correctly construed the term 'self-erecting' to require that the accused blankets form a curved or arched structure which stands off the patient." Add. at 11. The jury properly could have found literal self-erecting because when the accused blankets are inflated over a patient, they "move slightly away from the person," and the "shape" that they assume is literally "a curved or arched structure which stands off the patient."

C. The Literal Scope Of "Self-Erecting" Was Not And Should Not Be Limited To The Scope Of Dependent Claims Directed To A "Self-Supporting" Blanket.

This Court apparently misapprehended the jury's general verdict of equivalents to have been a verdict specifically directed to the self-erecting limitation. If not, then the Court must have assumed that either (i) none of the other disputed limitations could have been found equivalently as opposed to literally, or (ii) that "forming a curved or arched structure which stands off the

patient" means the same as "self-supporting." As to the other disputed elements, days of trial were devoted to Appellants' arguments that they did not have "seams" and "chambers" and to Augustine's showing that the accused blankets had at least the equivalents of seams and chambers. Augustine's Principal Brief at 19-29. Any of these other disputed elements easily could have been found by equivalents.

This Court should not rule that "forming a curved or arched structure which stands off the patient" means "self-supporting" or "does not touch the patient." This construction would be contrary to the one adopted by the trial court and nominally approved by this Court, and would violate the doctrine of claim differentiation. *See Transmatic, Inc. v. Gulton Indus., Inc.*, 53 F.3d 1270, 1277, 35 U.S.PQ.2d 1035, 1041 (Fed. Cir. 1995). The term "self-supporting," which may reasonably be construed to prohibit contact with the patient, is a limitation of dependent claim five of the '188 patent. The independent claims, which lack the limitation "self-supporting," should not be read to have the same scope. The parties did not brief or argue this issue of claim differentiation because the Appellants did not contest the trial court's definition.

Other dependent claims in the other patents make it clear that the tubes needed to form a self-supporting blanket are not a limitation of the asserted

independent claims. For example, claim 1 of the '102 patent is directed to a plurality of "chambers" rather than tubes. Dependent claim 10 adds the limitation of "mutually parallel, communicating tubular chambers." The specifications of each of the patents further note that "tubes are preferred since they impart shape and strength to the erected bathing structure; other inflatable structures are contemplated, however." (Emphasis added.) JA04430 col. 4 ll. 63-66; JA04631 col. 4 ll. 33-36; JA05038 col. 5 ll. 31-34. The clear teaching is that neither shape nor strength nor tubes -- the hallmarks of a self-supporting blanket -- are limitations of the independent claims.

Although Augustine argued for an even broader reading of self-erecting -- simple inflation of the blankets under air pressure alone -- to show that JMOL might have been required in Augustine's favor, no party suggested on appeal that the literal scope of self-erecting should be as narrow as self-supporting. Augustine merely pointed out that under a broader construction of "self-erecting," this Court might find the "self-erecting" limitation literally met as a matter of law and might find that all of the other disputed limitations were literally or equivalently present as a matter of law. The only narrow definition of "self-erecting" that still respects claim differentiation is the one given by the trial court

-- and not "self-supporting" -- which renders literal presence of the self-erecting element a question of fact properly submitted to the jury.

D. A Rehearing Is Necessary To Consider The Question Of Literal Infringement Of The Claim Limitation "Self-Erecting" Based On The Record.

Under *Comark*, this Court "cannot presume to ascertain which elements the jury found to be met only by equivalents." *Comark*, 156 F.3d at 1188, 48 U.S.P.Q.2d at 1006. This Court did presume that the jury in this case found infringement of the term self-erecting only by equivalents. Because this Court did not address literal infringement in its opinion, a rehearing is necessary.

ARGUMENT - SUGGESTION FOR REHEARING IN BANC

I. THE PANEL'S DECISION IS IN CONFLICT WITH THIS COURT'S DECISION IN *COMARK COMMUNICATIONS INC. V. HARRIS CORP.* REGARDING JURY VERDICTS WHERE THE VERDICT FORM DOES NOT STATE WHETHER A PARTICULAR LIMITATION WAS FOUND LITERALLY OR EQUIVALENTLY.

As fully explained in the Petition for Rehearing Argument Part I, *supra*, this Court's decision in *Comark* applies when a jury returns a verdict of infringement by the doctrine of equivalents and the verdict form does not state which elements were found literally and which were found equivalently. *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1187, 48 U.S.P.Q.2d 1001, 1005 (Fed. Cir. 1998). The decision of the panel in the present case assumes, without proof of any kind, that a particular limitation was found equivalently.

The decision in *Comark* is correct. The Court must uphold jury verdict's of the nature in question "if there is sufficient evidence of equivalents and linking testimony such that a reasonable jury could have found that at least one element was met by equivalents." *Comark*, 156 F.3d at 1188, 48 U.S.P.Q.2d at 1006. Otherwise the Court is only guessing as to what the jury found. A rehearing in banc is necessary to ensure consistency in the application of the rule announced in *Comark* and to avoid confusion and uncertainty among the trial bench and bar.

II. WHETHER THE SCOPE OF PROSECUTION HISTORY ESTOPPEL SHOULD BE DECIDED AS A MATTER OF LAW OR OF FACT IS A QUESTION OF EXCEPTIONAL IMPORTANCE.

Appellants put into evidence the application and scope of prosecution history estoppel in this case, including the nature of the doctrine, the statements creating an estoppel in this case and the scope of the estoppel. Trial Transcript, August 20, 1997, pp. 52-55 ll. 19-21; Trial Transcript, August 21, 1997, pp. 122-123 ll. 24-9; JA03960-03961 ll. 20-9. They argued the scope of estoppel to the jury in detail. At their request, the jury was instructed to consider whether Augustine could prevail consistently with the statements in the file history. The specific instruction given is as follows:

> The history of the prosecution of the patent application, that's called the file record or the written correspondence, for the applicant to the patent office is used to explain the meaning of the words used in the patent

23 claims. That's the file, wrapper, stuff you've been given.
24 A patent owner is estopped, you know the legal term, is
25 prevented from taking a position that is inconsistent with

197

1 the positions that the patentee took when attempting to
2 convince the patent trademark office to issue the patent.
3 This is called the document prosecution history
4 estoppel.

JA04186-04187 ll. 20-5. Thus, Appellants specifically asked the jury to make a factual finding as to the existence and scope of any estoppel. Having lost their gamble with the jury, Appellants now seek a second bite at the apple.

A. The Jury's Verdict Included The Jury's Consideration Of Estoppel And It Cannot Be Set Aside Without Offending The Seventh Amendment To The United States Constitution.

This Court and the Supreme Court have clearly established that the Seventh Amendment to the United States Constitution preserves the right of jury trial in patent cases. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S. Ct. 1384, 1389 (1996); *Paltex Corp. v. Mossinghoff*, 758 F.2d 594 (Fed. Cir. 1985). This Court has also explained that the scope of prosecution history estoppel depends upon a fact finding: what a reasonable competitor is entitled to conclude from a reading of the file history. *Haynes International Inc. v. Jessop Steel Co.*, 8 F.3d 1573, 28 U.S.P.Q.2d 1652 (Fed. Cir. 1993), *on reh'g*, 15 F.3d 1076, 29 U.S.P.Q.2d 1958 (Fed. Cir. 1994); *see also Modine Mfg. Co. v. U.S. Intern. Trade*

Com'n, 75 F.3d 1545, 1551 (Fed. Cir. 1996), *cert. denied*, 116 S. Ct. 1523 (1996) (explaining that the standard for determining the scope of estoppel is based on the reasonable reading, by a person of skill in the field of the invention, of the entire prosecution history). Where, as here, the jury is instructed to consider and rule on factual predicates to legal issues and returns a general verdict unaccompanied by the specific fact finding, the verdict includes the fact finding by necessary implication. *E.g.*, *DMI, Inc. v. Deere &Co.*, 802 F.2d 421 (Fed. Cir. 1986). In short, the jury's verdict in this case necessarily included a fact finding that reasonable competitors are not entitled to conclude that the scope of any estoppel surrendered the subject matter of the accused blankets.

The panel substituted its judgment for that of the jury with respect to the underlying factual predicate that determines the scope of estoppel. Although this Court has often announced that prosecution history estoppel is an issue of law for the court, counsel has found no specific guidance as to the jury's role in the specific factual predicate underlying the scope of estoppel. The patent bar and the trial bench would benefit substantially from consideration by this Court in banc whether juries should be permitted to consider the underlying factual question of what reasonable competitors may conclude from file histories and from clarification of what the legal standard for trial judges and on review should be,

when juries are asked to and find the scope of estoppel does not extend to the accused equivalent.

Moreover, having ruled that factual issues in patent cases are the subject of the right to jury trial, and having announced that the test for estoppel is a question which clearly depends on underlying factual questions, this Court has left uncertain the role of the Seventh Amendment in cases of prosecution history estoppel. Upon reconsideration in banc, Augustine would urge that the right to jury trial should include the underlying factual question of the scope of estoppel. Counsel would show that under the present state of the Court's jurisprudence, the right to jury trial in patent cases is materially diminished by de novo review in all cases, regardless of the basis for the jury's verdict.

CONCLUSION

For the foregoing reasons, Augustine Medical, Inc.'s petition for rehearing and suggestion for rehearing in banc should be granted.

Date: June 21, 1999

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
S.D. AUGUSTINE ET AL.	)	Group Art Unit: 3304
	)	
Serial No.: 08/419,719	)	Examiner: M. Graham
	)	
Filed: April 10, 1995	)	Docket No.: AUGA01000010
	)	

For: THERMAL BLANKET

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

REQUEST FOR CHANGE OF ADDRESS

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